

Application No.: 10/644,426

Docket No.: 60680-1638

REMARKS

Applicant has carefully reviewed the Office Action mailed April 19, 2005. Claims 1-8, 11, and 14-23 remain pending in this application. Applicant respectfully requests reconsideration of the present application in view of the following remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 1-7, 11, 14-18, and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stephenson et al.* in view of *Peterson*. Applicant respectfully traverses the rejection.

“The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d, at 1458 (Fed. Cir. 1998)

A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

NO MOTIVATION

Applicant respectfully traverses the 103(a) rejections because there is no suggestion, motivation, or objective reason to combine the cited references. “If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would

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ever issue.” *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). “Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability’.” *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

The Examiner has cited multiple motivations for combining Stephenson with the first and second tubular member construction of Peterson. These advantages are discussed, in turn, below. Applicant respectfully submits that these purported advantages would not motivate one skilled in the art to combine the references for at least the reasons below.

Fastener Screwed from Both Sides

The Examiner states that one skilled in the art would be motivated, with Stephenson in hand, to seek out Peterson to find a mounting that does not require a fastener that must be screwed from each side (See Office Action, paragraph 6; Stephenson, FIG. 3).

Apparently, the Examiner is under the assumption that the first and second tubular members of Peterson provide a mount where the fastener not required to be manipulated from both ends when tightened. “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper.” *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int., 1986). The Examiner is respectfully requested to explain in greater detail how the fastener of Peterson can be tightened by only turning head 52 of fastener 20. Additionally, the Examiner is specifically requested to explain how this ‘fastening from one side’ is different from the fastener provided in Stephenson.

As detailed in column 5, lines 1-9 of Peterson, the fastener 20 is inserted through the first and second tubular members and then the fastener 20 is engaged with nut 51. Therefore, Peterson appears to provide a fastener that must be tightened with opposing forces exerted through nut 51 and head 52 in order to tighten fastener 20. Interestingly, this is just the type of fastener that Stephenson mentions in column 1, lines 38-50 when Stephenson discusses fasteners that are associated with alignment problems.

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Therefore, one skilled in the art, with Stephenson in hand, would not be motivated to seek out a reference to teach a mounting that does not require that a fastener be screwed from each side, as asserted by Examiner, as this teaching is contained in Stephenson.

Additionally, the Applicant notes that the Examiner has made a combination of the mount of Stephenson with the first and second tubular member construction of Peterson. Therefore, even if there were proper motivation to combine the fastener of Peterson with the mount of Stephenson, this combination would not include the first and second tubular member construction of Peterson.

Single Fastener

As best described in column 1, lines 38-50, Stephenson solves the Examiner's alignment issue (discussed below) by providing a mount that is assembled in two parts. First the lower portion of the mount is assembled onto the chassis brackets 14 of an automobile with a first fastener. Then holes in the body 32 may be aligned with the mounts and a second fastener used to secure the body to the mount. Importantly, Stephenson presents this two-part mount as a solution to the difficulties in using a single bolt. (See Column 1, lines 40-44) that must be inserted through a mount as all pieces of the mount, the holes in each bracket and the holes in the body are aligned. Therefore, Stephenson encourages one skilled in the art to avoid a single bolt when fastening a mount. Accordingly, Stephenson *teaches away* from the proposed combination by discouraging one of skill in the art from combining a single bolt fastener with the mount of Stephenson.

Labor Intensive

The Examiner also mentions that the mount of Stephenson would be labor intensive when compared to the mount of Peterson. At best, this purported motivation is a reason why one skilled in the art would choose Peterson instead of Stephenson, since the Examiner has not alleged that any particular feature of the mount of Stephenson is desirable in the mount produced by the combination. As mentioned above, Stephenson presents a two fastener mount that alleviates the misalignment problems associated with a single fastener mount. The Examiner has not identified any motivation within either Stephenson or Peterson for the proposed combination. Therefore, one skilled in the art would select between either Stephenson or

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Peterson (or other references) if a single reference could solve the problem confronting the inventor. *In re Rouffet*. Accordingly, as the Examiner has proffered a motivation that may encourage one skilled in the art to select the mount of Peterson, but the Examiner has not provided a motivation to combine the mount of Stephenson with the first and second tubular members of Peterson.

Misalignment

The examiner also states that the first and second tubular members of Peterson would prevent the mount of Stephenson "from being assembled improperly from misalignment." (Office Action dated April 19, 2005, Section 4, page 3). As mentioned above, Stephenson discusses alignment problems associated with a single fastener in Column 1, lines 38-50. Furthermore, Stephenson *provides* a solution to alignment and would *discourage* one skilled in the art from looking further for a mount.

"When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper." *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int., 1986).

The Examiner is respectfully requested, in accordance with *Ex parte Skinner*, to explain how aligning the first and second tubular members of Peterson would prevent the mount of Stephenson from being "assembled improperly from misalignment". It would appear that the other items of the mount must be properly aligned in order to insert the second tubular member 14 into the first tubular member 12. The Applicant can locate no features of the first and second tubular member construction of Peterson that provides any alignment advantage that is not provided in Stephenson. Therefore, the Applicant is confused as to how the first and second tubular member construction *prevents* misalignment, and requires the requested clarification.

A detailed review of the mounts disclosed in Stephenson and Peterson does not reveal any misalignment advantages associated with Peterson that do not exist in Stephenson. To the contrary, the mount of Stephenson, either FIG. 2, or FIG. 3, is to be assembled in two steps that would seem to reduce alignment problems associated with aligning multiple items (elastomers, spacers, washers, body panels, brackets, etc.). In the first step of Stephenson, the lower portion of the mounting 15 is attached to the bracket 14 by tightening either T-shaped bolt 19 (FIG. 2) or

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bolt 30 (FIG. 3). In the second step, the body 28 is attached to mounting 15 by either bolt 27 (FIG. 2) or bolt 31 (FIG. 3). By teaching a two step process, misalignment problems are reduced as fewer items must be aligned when inserting a bolt therethrough.

Indeed, FIG. 2 of Stephenson requires that the T-shaped bolt 19 be interposed through 4 items (puck 17, flange 16, puck 18, and washer 20) before the nut (illustrated above as N) is threaded onto T-shaped bolt 19. However, Peterson requires that at least 7 items [item M (not named, but appearing to be an automobile body or cab), spacer 12, first elastically resilient mating ring 16, item S (not named, but appearing to be an ear extending from an automobile frame), second elastically resilient mating ring 18, spring element 100, and thimble 14] be assembled before fastener 20 can be threaded onto nut 51. Therefore, misalignment would be more likely with Peterson than Stephenson, (See Stephenson, Column 1, lines 40-44) and accordingly, one skilled in the art, with Stephenson in hand, would discard Peterson when looking for a mounting that reduces misalignment. The only mention of aligning within Peterson is for aligning tabs 108 that assist in engaging thimble 14 with spring element 100 *after* the 7 items mentioned are aligned for assembly.

Dimple Spring Mechanism

The examiner also states that the dimple spring mechanism 100 of Peterson would prevent the mount of Stephenson from falling apart if the fastener fails. (Office Action dated April 19, 2005, Section 4, page 3).

The dimple spring mechanism of Peterson is provided to allow repeated assembly and disassembly of the mount. (Peterson, Column 2, lines 47-51, Column 4, lines 49-57). Therefore, the dimple spring mechanism 100 of Peterson **allows** the mount to be taken apart when the fastener is removed, and would presumably allow the mount to fall apart in the event of a fastener failure.

As clearly seen in FIG. 1 of Peterson, the dimple spring mechanism 100 may, through interference between holding tabs 104 and enlarged end 44, retain mating rings 16, 18 onto chassis S after failure of fastener 20. However, a close examination of Peterson reveals that failure of fastener 20 would result in separation of the automobile body M from the ear S of the automobile frame. The Examiner is reminded that the motivation provided must motivate *one*

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skilled in the art to make the proposed combination. The Examiner is respectfully requested, in accordance with *Ex parte Skinner*, to explain exactly why one skilled in the art would desire a mount that does not fully fall apart in the event of a fastener failure that allows an automobile body to separate from the chassis.

Dependent Claims

It is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

Dependent claims 2-7, 11, 15-18, and 21-22 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, dependent claims 5 and 17 positively recite the limitation that the second, or tubular member 22 "includes a dimple for engaging a fastener." In contrast, the thimble tube cylindrical portion 42 of Peterson does not appear to be a dimple, and clearly is not taught to engage threaded portion 82 of fastener 20. (See column 5, lines 1-9).

Claims 8, 19, 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stephenson*, as modified, in view of *Schmidt* (U.S. Patent No. 3,390,709). For at least the following reasons, Applicant respectfully traverses the rejection.

Applicant notes that dependent claims 8, 19, and 23 depend from independent claims 1, 14, and 20, respectively. Accordingly, these claims are allowable by being dependent on an allowable independent claim.

Examiner's Response to Arguments

In the Examiner's Response to Arguments (Office Action dated April 21, 2005, Section 6), The Examiner has presented additional motivations for the proposed combination of *Stephenson* and *Peterson* that were not mentioned in the 103 rejection above. Accordingly, these additional motivations are addressed below.

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Hexagonal Surfaces

The Examiner states that “[p]eterson uses features like the hexagonal surfaces 26, 38 to ensure that the elements can only be assembled in a correct orientation.” Applicants do not understand how the hexagonal surfaces of Peterson assist in alignment of the mount of Peterson. As in the discussion above, the Examiner is reminded that the mount of Peterson must be fully aligned before the hexagonal surfaces interact as the second tubular member is slid into the first tubular member.

Accordingly, the Examiner is requested, in accordance with *Ex parte Skinner*, to describe fully the incorrect orientations that are prevented by the hexagonal surfaces of Peterson. Furthermore, it appears that any incorrect orientations between the first and second tubular members (the Examiner’s motivation) was not possible with the mount of Stephenson prior to the addition of the first and second tubular members of Peterson. It appears to the Applicant that the hexagonal surfaces of the first and second tubular members of Peterson circumferentially align the first and second tubular members as the second tubular member is slid into the first tubular member *after* the elements of the mount have been properly aligned. The Applicant cannot identify any advantage provided by the hexagonal surfaces of Peterson in aligning the pucks and other elements of the mount of Stephenson.

It is important to note that Stephenson does not suffer from misalignment inadequacies. To the contrary, Stephenson presents a solution to misalignment when securing a mount with a single fastener. Importantly, the Applicant notes that the Examiner has introduced a misalignment problem into the mount of Stephenson by including the first and second tubular members of Peterson and then solved the misalignment problem by alleging that the first and second tubular members include a feature that will “ensure that the elements can only be assembled in a correct orientation.”

Nested Tubes Prevent Misalignment

In support of the Examiner’s contention that the first and second tubular member construction of Peterson combination with the mount of Stephenson is a proper combination, the Examiner has alleged that “the nested tubes as shown prevents misalignment.”

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“When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper.” *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int., 1986).

The Examiner is respectfully requested, in accordance with *Ex parte Skinner*, to explain how aligning the parts in order to nest the tubes *prevents* misalignment. It would appear that the mount of Stephenson with a single bolt would require the same difficulty in alignment as the nested tubes of Peterson. The only difference being that after the tubes of Peterson are nested, a bolt must be inserted through the tubes and threaded onto nut 51. Therefore, the Examiner has seemingly made an argument that supports the fact that Peterson provides a device that is more difficult to align than Stephenson.

Assuming *arguendo* that the Examiner is correct in that the mount of Stephenson may be secured by a single bolt to somehow *correct* a misalignment problem, then at best the mount assembled with the Examiner's proposed combination is not the mount as claimed in independent claims 1, 14, and 20. Specifically, one skilled in the art would recognize that

Interference of the Fastener and the Dimple

It is significant to note that the third purported motivation in the Response to Arguments (Office Action, Section 6, page 4, last paragraph) is not consistent with the third purported motivation in the 35 USC §103 Rejection (Office Action, section 4, page 3), discussed above. Accordingly, the different motivations will be addressed separately, with the third motivation provided in the 35 USC §103 Rejection discussed above and the third motivation provided in the Response to Arguments discussed below.

Specifically, the Examiner provided a purported motivation in the 103 rejection by alleging that “the dimple spring mechanism 100 prevents the mount 10 from falling apart even if the fastener 20 fails” (numerals added).

In the Response to Arguments, the Examiner mentions that *if* the fastener 20 of Peterson were to fail below the dimple 42 (presumably between 42 and 51), then the device of Peterson would be held together by the interference of the fastener 20 and the dimple 42.

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First, Applicant disagrees with the Examiner that Peterson teaches sufficient interference between the dimple 42 and the threaded portion 82 of the fastener 20 to hold the mount together. Column 5, lines 1-9 of Peterson describes how fastener 20 is inserted through the mount and then "engages the nut 51." No mention is made of the fastener engaging the dimple 42. Significantly, FIG. 2 of Peterson illustrates a cut away view of the dimple 42 showing a smooth interior surface. FIG. 2 of Peterson also illustrates the interior portion of nut 51 with contour lines that illustrate the threaded surface. Additionally, the description of dimple 42 in column 3, lines 32-49 of Peterson makes no mention of any feature on the interior surface that would interfere with the fastener 20. Therefore, if the dimple 42 is to allow fastener 20 to pass through as described in Column 5, lines 1-9, then Peterson teaches a dimple 42 that would not prevent the mount from falling apart in the event of a fastener failure.

Second, assuming *arguendo* that one skilled in the art would be motivated to use the first and second tubular member construction of Peterson with a mount in order to use a device that would be held together by interference between a dimple and a fastener in the event of a failure of the fastener, and assuming *arguendo* that the first and second tubular member construction of Peterson provides such a mount, then the Examiner has provided a reason to choose Peterson *instead* of Stephenson. As stated earlier, the Examiner must provide a motivation to motivate one skilled in the art to make the proposed combination. However, the motivation offered by the Examiner is directed to the features of Peterson, and in no way involves the device of Stephenson or provides any incentive to combine Peterson with Stephenson. The mount of Peterson would provide a mount that has all of the features espoused by the Examiner.

Furthermore, a close examination of Peterson reveals that failure of fastener 20 would result in separation of the automobile body M from the ear S of the automobile frame. Although Applicant questions the likelihood of one skilled in the art desiring that a mount hold together when the body separates from the frame of an automobile during a fastener failure or other postulated accident, the mount of Stephenson affords an identical attribute. In the event of a failure of either bolt 27 (FIG. 2) or bolt 31 (FIG. 3), the remainder of mount 15 would not fall apart. Thus, one skilled in the art, with Stephenson in hand, would not need to look to Peterson,

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or any other reference, to find a mounting that would not fall apart in the event of a fastener failure since Stephenson fulfills this need.

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed no fees are due with this response. However, if any fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 60680-1638 from which the undersigned is authorized to draw.

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